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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,473	11/30/2000	Sang Hyun Han	HI-021	1714
34610	7590	12/18/2003	EXAMINER	
FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			TAYLOR, BARRY W	
			ART UNIT	PAPER NUMBER
			2643	
			DATE MAILED: 12/18/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,473

Applicant(s)

HAN, SANG HYUN

Examiner

Barry W Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. In view of the Appeal Brief filed on 9/30/03, PROSECUTION IS HEREBY REOPENED. Rejections set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-11, 13-16, 18-27 and 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayak (6,192,116) in view of Reese (6,618,474).

Regarding claims 1, 6, 13, 18, 20, 31, and 33-34. Mayak teaches system and method for generating caller Id/caller id-call waiting information (i.e. CID/CIDCW) wherein information is inputted from first phone (see phone 1 figure 3) and sent to Central Office. The Central Office receives the inputted message and a destination number and attaches the user inputted message to either CID or CIDCW to produce a destination message (see figures 4A-4B wherein Central office supplies user inputted message with caller id information to particular destination (i.e. phone 2).

Mayak does not explicitly show the inputted information is from an information provider.

Reese teaches method and apparatus for providing a customer a promotional message (i.e. slogan, company's name, product, etc.) via CID or CIDCW (col. 2 lines 29-37).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the user inputted message as taught by Mayak to include a promotional advertisement as taught by Reese for the benefit of allowing telemarketers

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to be identified by product name or slogan instead of typical caller-id (i.e. "private" caller) thus increasing the probability of having telemarketing calls answered.

Regarding claim 2. Mayak teaches subscriber device displaying the information (see figures 4A and 4B wherein user inputted message modulated with standard caller id and delivered to phone 2).

Regarding claim 3. Mayak teaches the modulated caller id information with alpha-numeric message (col. 2 lines 24-32).

Regarding claims 4 and 21-22. Mayak does not explicitly show the inputted information is from advertisement company.

Reese teaches method and apparatus for providing a customer a promotional message (i.e. slogan, company's name, product, etc.) via CID or CIDCW (col. 2 lines 29-37).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the user inputted message as taught by Mayak to include a promotional advertisement as taught by Reese for the benefit of allowing telemarketers to be identified by product name or slogan instead of typical caller-id (i.e. "private" caller) thus increasing the probability of having telemarketing calls answered.

Regarding claim 5. Mayak discloses modulating caller id with inputted message and delivering to caller id device.

However, Mayak does not explicitly show advertisement company delivering advertisement.

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Reese teaches method and apparatus for providing a customer a promotional message (i.e. slogan, company's name, product, etc.) via CID or CIDCW (col. 2 lines 29-37).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the user inputted message as taught by Mayak to include a promotional advertisement as taught by Reese for the benefit of allowing telemarketers to be identified by product name or slogan instead of typical caller-id (i.e. "private" caller) thus increasing the probability of having telemarketing calls answered.

Therefore, it would have been obvious for any one of ordinary skill in the art at the time of the invention to modify the teachings of Robuck by moving the call screening service to telephone company equipment providing the call screening service as taught by Hill for the benefit of allowing private calling parties ability to override their privacy by entering the digit.

Regarding claims 7 and 14. Mayak teaches FSK used (col. 2 line 49).

Regarding claims 8-9. Mayak teaches the caller id modulated text message may be composed at user phone before sending to central office (col. 4 lines 5-31).

Regarding claims 10-11. Mayak teaches the central office modulates caller id with text after off-hook detected (col. 4 lines 58-60, col. 5 lines 57-58).

Regarding claim 15. Mayak does not show icon.

Reese teaches method and apparatus for providing a customer a promotional message (i.e. slogan, company's name, product, etc.) via CID or CIDCW (col. 2 lines 29-37).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the user inputted message as taught by Mayak to include a promotional advertisement as taught by Reese for the benefit of allowing telemarketers to be identified by product name or slogan instead of typical caller-id (i.e. "private" caller) thus increasing the probability of having telemarketing calls answered.

Regarding claim 16 and 23. Mayak teaches using modulated caller id with user inputted message. Reese also teaches FSK used to modulate caller id with slogan, company's name, product, etc.

Regarding claims 19 and 32. Mayak teaches the central office stores the caller id and user inputted message while determining if destination is currently in use or not (col. 2 lines 63-67).

Regarding claims 29 and 35. Mayak does not show identifying advertiser.

Reese teaches method and apparatus for providing a customer a promotional message (i.e. slogan, company's name, product, etc.) via CID or CIDCW (col. 2 lines 29-37).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the user inputted message as taught by Mayak to include a promotional advertisement as taught by Reese for the benefit of allowing telemarketers to be identified by product name or slogan instead of typical caller-id (i.e. "private" caller) thus increasing the probability of having telemarketing calls answered.

Regarding claims 24-27. Mayak shows the central office receives user inputted message (figure 3) and modulates the inputted signal with caller id (figures 4A-4B) to form output modulated caller id message.

Regarding claim 30. Mayak teaches the receiving terminal (see phone 2 figures 4A-4B) receive modulated caller id with user inputted message.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayak (6,192,116) in view of Reese (6,618,474) further in view of Lederman (5,448,625).

Regarding claim 17. Mayak in view of Reese do not show payment of charges for reception of advertisement.

Lederman teaches telephone advertisement method and apparatus wherein promotional advertisement is provided to caller or called party thereby reducing cost of telephone call since advertiser bears some or all of the cost of the call (col. 2 lines 61-64).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Mayak in view of Reese to use promotional advertisement as taught by Lederman for the benefit of reducing telephone charges when caller or called party receives advertisement.

4. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayak (6,192,116) in view of Reese (6,618,474) further in view of Reese (6,427,009).

Regarding claim 28. Mayak in view of Reese do not show using wireless exchange.

Reese (6,427,009) teaches using cellular exchanges (col. 1 lines 10-22, col. 2 lines 15-30, col. 3 lines 1-22, col. 8 lines 62-65, col. 9 lines 1-5) allowing the calling party to access telephone or cellular company so as to control the disclosure of the calling party DN to a called party who subscribes to caller ID or to any other CLASS services. Reese also discloses the called party also capable of receiving caller ID information from telephone or wireless (col. 1 lines 10-22, col. 2 lines 15-30, col. 3 lines 1-22, col. 8 lines 62-65, col. 9 lines 1-5).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Mayak in view of Reese (6,618,474) to use wireless telephone exchanges as taught by Reese (6,427,009) for the benefit of allowing the calling party control the disclosure of caller ID information to subscribers who subscribe to CLASS services by accessing cellular company originating central office equipment.

Response to Arguments

5. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor whose telephone number is (703) 305-4811. The examiner can normally be reached on Monday-Friday from 6:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 customer service Office whose telephone number is (703) 306-0377.

Patent Examiner
Barry W. Taylor

[Signature]
CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600